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14 Apr 2005

**To:**

**Sent to:** USPTO TC 2800 **Fax:** 571-273-8300  
**Attention:** Primary Examiner Gail Verbitsky **Phone:** 571-272-2253  
**Subject:** Response to Restriction Requirement

**Total Pages (Including Cover Sheet): 9**

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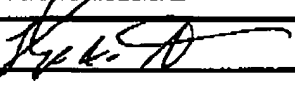
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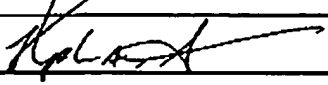
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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/801,294	
	Filing Date	3/17/2004	
	First Named Inventor	Geoff E. Fair	
	Art Unit	2859	
	Examiner Name	Verbitsky, Gail K	
Total Number of Pages in This Submission	8	Attorney Docket Number	AFD 694

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PATENT

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**In re Application of:** Fair et al.  
**Application Serial No.:** 10/801,294  
**Filing Date:** 17 March 2004  
**For:** Thermal History Sensor  
**Examiner:** Verbitsky, Gail K.

**Confirmation No.:** 3040

**Group Art Unit:** 2859

**Customer Number:** 26902

**Attorney Docket No.:** AFD694

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**APR 14 2005**

**REQUEST FOR RECONSIDERATION OF RESTRICTION REQUIREMENT**  
**UNDER 37 CFR § 1.143**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Action mailed 22 March 2005, applicant respectfully traverses the restriction requirement.

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### Remarks

The Examiner's Action mailed 22 March 2005 has been received and reviewed. Claims 1-19 are pending. Claims 1-19 are subject to restriction. This response is being submitted pursuant to 37 CFR § 1.143.

Applicant respectfully traverses and requests reconsideration and withdrawal of the restriction requirement in view of the following remarks.

### Restriction Requirement

The Examiner imposed a restriction requirement under 35 USC § 121 to one of two "inventions," identified by the Examiner as follows:

**Group I.** Claims 1-8 and 13-19, drawn to thermal history sensor based on opacity, classified in class 374, subclass 161;

**Group II.** Claims 9-12, drawn to thermal history sensor, classified in class 374, subclass 102.

### Discussion

Group I and Group II are not "independent and distinct inventions" under 35 USC § 121. The Examiner alleges that if it can be shown that these Groups "are [two different combinations,] not disclosed as capable of use together, having different modes of operation, different functions or different effects," then they are "unrelated" for purposes of MPEP § 806.04.

In support of this claim, Examiner states that Group I "requires to be exposed to the particular (400K) temperature, requires a set of stressors and requires to respond to the set of stressors with difference changes of opacity of the substrates, while [Group II] requires the attachment means and that the reflective surface is platinum, not required by [Group I]."

The logical conclusion of this reasoning is that every independent claim is "independent and distinct" from every other independent claim. After all, if there is any restriction that is not present in the other claim, according to any logical extension of this reasoning, then they are subject to a restriction requirement. In other words, by reciting certain elements of the claims (including a recitation of platinum in a dependent claim!) as putative evidence of being "independent and distinct," the only logical conclusion is that a restriction would be proper

whenever there is more than one independent claim. This, clearly, has never been the case in the history of United States patent law.

1. Federal law, which supersedes any contrary provision in the Code of Federal Regulations or the Manual of Patent Examining Procedure, gives the Commissioner the discretion to restrict an application to one invention where the application contains “independent and distinct inventions.” The Examiner has not even alleged that Group I and Group II are independent inventions. This is not mere semantics; the two terms have distinct meanings, as MPEP § 802.01 makes clear. Accordingly, restriction is not permissible under 35 USC § 121.

2. The Examiner has failed to make a prima facie case for restriction under the law. Though the Examiner alleged that Group I and Group II are “distinct,” and provided reasons (quoted above), the Examiner failed to then show, as required, why the “distinct inventions” must be restricted on the basis of (a) separate classification; (b) separate status in the art; or (c) a different field of search.

a. The Examiner makes the allegation that Group I belongs to subclass 161 and Group II belongs to subclass 102. This does not meet the Examiner’s burden of showing that they are distinct based on separate classification. First, subclasses are by definition related to each other – they both belong under a single class. The classification under separate subclasses is simply for cataloging purposes and is not sufficient justification to support a restriction requirement. Second, Group I and Group II each belong to both cited subclasses. Group I belongs to subclass 102 as well as to 161; likewise, Group II belongs to subclass 161 as well as to 102. Indeed, there are likely a number of other subclasses in which both Group I and Group II could be asserted to belong (such as, for example, 123, 132, 134, 137, 210 etc). The Examiner has not provided any evidence that each has attained recognition in the art as a separate subject for inventive effort or that a separate field of search is necessary or even appropriate.

b. The only attempt to show that restriction is permissible based on “separate status in the art” is at paragraph 3 of the Examiner’s Action. Here, the Examiner merely makes the blanket assertion that Group I and Group II “have acquired a separate status in

the art because of their recognized divergent subject matter." This does not rise to the level of a prima facie case. Indeed, the applicant does not understand how this is anything more than simply restating the allegation. As the MPEP makes clear, however:

Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween as set forth in the following sections.

MPEP § 808

The Examiner must provide an appropriate explanation to support this allegation.

Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

MPEP § 808.02

No patents were cited, nor was any allegation made that a separate field of search is required, in attempting to show that Group I and Group II "have acquired a separate status in the art." Accordingly, the Examiner has failed to make a prima facie case for restriction.

3. Not only has the Examiner failed to make a prima facie case for restriction, but Group I and Group II are not independent.

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.

MPEP § 802.01

Indeed, the Examiner has made no allegation of independent subjects disclosed in the application. The Examiner has not identified any "genus" and "species" or "process and apparatus" such that the definition of "independent" would apply.

Not only are Group I and Group II not "unconnected in design, operation or effect," but they have the same design, operation and effect. They are designed in the same way – namely, both include a plurality of glass ceramic substrates with different compositions. They also have the same operation and effect – namely, the glass ceramic substrates both respond to thermal stressors.

4. Not only has the Examiner failed to make a prima facie case for restriction, and not only are Group I and Group II not independent, but Group I and Group II are also not distinct.

The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

**MPEP § 802.01**

The Examiner has made no allegation, much less provided any evidence, that Group I and Group II are capable of separate manufacture, use or sale as claimed. The Examiner has therefore failed to make a prima facie case of distinct inventions, as required by the explicit definition under the MPEP.

5. Even if a restriction requirement was legally permissible in this case (which it is not), it is not appropriate. Restriction is discretionary where it is legally permissible, as it may be more convenient and efficient to keep multiple groups of inventions in a single patent. Here, both Groups should be examined together in the same application to preserve unity of invention and avoid duplication of effort by requiring multiple searches in the same fields.

6. As required by 37 CFR § 1.143, the applicant hereby makes the provisional election to pursue the claims under Group I.

7. The applicant respectfully requests that the Examiner, in the event the Examiner does not reconsider and withdraw the restriction requirement, makes this restriction requirement final for purposes of 37 CFR § 1.144.

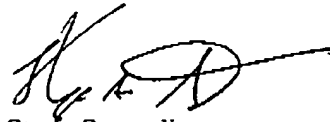


**Conclusion**

In view of the foregoing remarks, applicant respectfully traverses and requests reconsideration and withdrawal of the restriction requirement.

In the event any questions remain after consideration of this response, the Examiner is respectfully requested to contact applicant's attorney at the address, telephone, or email address provided below.

Respectfully submitted,



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